

REMARKS

Claims 1-13 and 15-18 are pending in this application. By this Amendment, claims 1 and 17 are amended. No new matter is added because the amendments are made to 1) clarify subject matter and 2) correct informalities. Reconsideration of the application based upon the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representatives by Examiner Gelagay during the June 20, 2007 personal interview. Applicants' separate record of a summary of the substance of the personal interview is contained in the following remarks.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed below; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

The Office Action, in paragraphs 5-8, rejects claims 1-18 under 35 U.S.C. §112, second paragraph, as being indefinite and as being incomplete for omitting essential steps. The Office Action asserts that it is unclear how a deciding device decides whether or not to encrypt data inputted. The Office Action further asserts that the omitted essential step relates to an uncertain outcome of a decision made to not encrypt data inputted. Although Applicants do not concede that these rejections are proper, in the interest of advancing prosecution toward allowance, claims 1 and 17 are voluntarily amended to obviate these rejections.

During the June 20 personal interview, Applicants' representatives discussed the proposed claim amendments with the Examiner. The Examiner agreed that the §112 rejection should be withdrawn in view of the proposed claim amendments. Based on the agreement reached with the Examiner, Applicants understand that the claim amendments should be entered. Accordingly, reconsideration and withdrawal of the rejections of claims 1-18 under 35 U.S.C. §112, second paragraph, are respectfully requested.

The Office Action, in paragraph 11, rejects claims 1, 3 and 15-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,805,706 to Davis in view of U.S. Patent No. 7,180,909 to Achler. The Office Action, in paragraph 12, rejects claim 4 under 35 U.S.C. §103(a) as being unpatentable over Davis in view of Achler and U.S. Patent No. 7,093,295 to Saito. The Office Action, in paragraph 13, rejects claims 2, 5-13 and 18 under 35 U.S.C. §103(a) as being unpatentable over Davis in view of Achler, Saito and U.S. Patent No. 5,677,952 to Blakley III. These rejections are respectfully traversed.

The Office Action, in paragraph 11, concedes that Davis does not teach a deciding device for deciding whether or not to encrypt data decrypted by the decryption module as recited in claim 1. Claim 17 recites similar features. To cure this deficiency, the Office Action asserts that Achler discloses a deciding device that teaches this feature. The Office Action summarily concludes that it would have been obvious to one of ordinary skill in the art to modify Davis with Achler to render obvious the combinations of all of the features recited in claims 1 and 17. The Office Action indicates that the combination would have been obvious "in order to have a system with great deal of flexibility with regard to how transmitted data may be treated by deciding whether to encrypt or not encrypt data" (citing Achler at col. 15, line 38-44). The analysis of the Office Action fails for at least the following reasons.

Neither Davis nor Achler, individually or in combination, teach, nor can they reasonably be considered to have suggested, at least the combinations of all of the features recited in claims 1 and 17. To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). During the June 20, 2007 personal interview, Applicants' representatives pointed out that while Achler arguably teaches a decision mechanism, Achler does not teach a deciding device for deciding whether or not to encrypt data decrypted by a decryption module, as positively recited in claim 1. Claim 17 recites similar features.

The Examiner asserted that Davis and Achler, in combination, teach features that allegedly correspond to this feature in combination with all of the features recited in claims 1 and 17. However, even if Davis is considered to teach a decryption module, and a re-encryption module, it is unreasonable to assert that the above-recited feature would have been rendered obvious by combining a deciding mechanism, that does not contemplate deciding whether to encrypt data decrypted by a decrypting device, with the Davis device. The Examiner stated that she would take these arguments into further consideration in response to any formal filing by Applicants.

Additionally, MPEP §2141.02 states, "[a]scertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art reference as a whole." Further, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Given the above alleged disclosures, as supplemented by the

discussion below, it is unreasonable to conclude that this standard is met in the asserted combinations of references. Even if the combined applied references were considered to teach the individual features recited in claims 1 and 17, one of ordinary skill would not have found motivation to make this asserted combination in order to render obvious the subject matter of the pending claims.

Davis teaches encryption of decrypted encrypted data in the field of cryptology (Abstract). Specifically, Davis teaches an apparatus and/or method that addresses a shortfall in the prior art regarding transfer of encrypted data and potential exposure of that data in a decrypted form (see, e.g., col. 1 lines 47-67). Davis addresses this issue with a device and/or method in which information encrypted in a first encrypted format is decrypted and re-encrypted according to a second encrypted format entirely within the cryptographic device (see col. 2, lines 36-44).

Achler teaches an apparatus and a method for modularly dealing with data, each module most efficiently dealing with the data based on the manipulation scheme associated with that module including in one module a means for deciding whether to encrypt compressible data (col. 15, lines 14-63).

Davis does not contemplate a deciding mechanism because there is no decision to be made. Davis is by design limited to receiving encrypted data, decrypting that data, and re-encrypting the same data using a different encryption key. In other words, this defines Davis' method of operation. It is unreasonable to assert that one of ordinary skill in the art would have been motivated to complicate the system and method of Davis with additional steps, particularly those suggested by the Office Action. To modify the primary reference in this manner would render Davis unsuitable to its intended purpose of seamlessly re-encrypting decrypted data. For this reason alone, one of ordinary skill in the art would not have been motivated to make the asserted combination.

Further, there is no evidence to show that there would have been any reasonable expectation of success in modifying Davis with Achler. As discussed above, Davis and Achler stem from different fields of endeavor. Likewise, because Davis does not contemplate a deciding mechanism and teaches away from such modifications, it is unreasonable to assert that one of ordinary skill in the art would have anticipated any measure of success in combining the applied references in the manner suggested.

Second, even if the applied references were combinable in any permissible manner, the asserted motivation to combine Davis and Achler in the Office Action falls short of meeting the required standard for such a showing. As indicated above, the Office Action asserts that it would have been obvious to one of ordinary skill in the art to modify the method disclosed by Davis with Achler in order to have a system with a great deal of flexibility with regard to how transmitted data may be treated by deciding whether to encrypt or not to encrypt data. This assertion is incorrect.

In support of this assertion, the Office Action cites col. 15, lines 38-44 of Achler, which states "[i]rrespective whether compression is performed, another independent decision is made whether to encrypt. There is thus a great deal of flexibility with regard to how data may be treated prior to being sent onward to the receiving device/interface." It is unreasonable to assert that this portion, or any portion, of Achler provides motivation to combine the reference with Davis. The quoted portion of Achler merely teaches that the decision to encrypt gives flexibility to the Achler system. It is not at issue here whether the introduction of a decision point in a given system, the Achler system, renders that system more flexible. At issue, rather, is whether Achler provides any motivation for combining features of the Achler system with the Davis device to overcome the deficiencies of Davis. The alleged motivation cited in Achler is a mere recitation of a specific feature of Achler limited to that reference.

During the June 20 personal interview, Applicants' representatives presented the above arguments to the Examiner. The Examiner stated that she would take these arguments into further consideration in response to any formal filing by the Applicants.

For at least the foregoing reasons, the asserted combination of applied references cannot reasonably be considered to have suggested the combinations of all of the features positively recited in independent claims 1 and 17. Additionally, and because neither of Saito or Blakely III is applied in any manner that would overcome the above-identified shortfall in the application of Davis and Achler to the subject matter of the pending claims, claims 2-13, 15, 16 and 18 also would not have been suggested by the combinations of applied references for at least the respective dependence of these claims, directly or indirectly, on allowable independent claims 1 and 17, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejections of claims 1-13 and 15-18 under 35 U.S.C. § 103(a) as being unpatentable over the varying combinations of applied references are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-13 and 15-18 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



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